

Declaration with Exhibits (37 CFR 1.132)

Filed on April 17, 2007 (as shown by Auto-Reply copy below)

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0PR-17-2607 OFFICE ACTION BY CHRISTOPHER J. RYAN EPO DATE 2007 2288 P.91

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Charles O. Townley Attn: Group Art Unit 3731
Serial No. 10/759,455 Primary Examiner
Filing Date 03/19/2004 Brian S. Follegren
Docket No. TOWNL-06041V
MODULAR BONE THUMB JOINT IMPLANT Amendment

Commissioner for Patents, Alexandria, VA 22311-4350

I certify that this correspondence is facsimile-transmitted to the Patent and Trademark Office (571 273 6100) on 11 APR 2007:

Christopher JOHN Ryan Christopher John Ryan 4/11/2007

Thank you for the 01/17/2007 Office action for the present application. In reply to that action, please reconsider and further examine the application, and in light of the present correspondence withdraw the standing rejections.

CLAIMS AMENDMENTS are attached hereto.

This amendment more particularly points out and distinctly claims the invention, and is fully supported by the original and underlying specifications, including drawings. No new matter is added hereby. Claims 31-42 remain present. No extra fee is due.

Tweezer species A is cited as a one-piece bony thumb joint implant, the reverse of the 35 USC 101 restriction of species is withdrawn. All present claims, which require modularity, read on the thus elected and examined species, 3, C and E.

As may apply to the present claims, each of the rejections set forth in the outstanding action is respectfully traversed.

Regarding the rejection of claims 31-34, 36, 40 and 41 under 35 USC 102(b) over Townley, US 20040069, each of claims 31 and 41 requires a head utilizing for mounting in and articulating with a correspondingly shapedly proximal surface of trapezium bone stock, and the stem of a single for intramedullary insertion in metacarpal bone stock. Such side limitations are material claim elements and must be taken into account. See, In re Harnisch, 578 F.2d 204, 205, 244 (CCP, 1977). The prior art does not describe either of these side limitations. In fact, the device of Townley '065 is a hip implant, which is well known to be much larger than a hand thumb implant, moreover, modularity to the hip implant of Townley '065 is not described, and unlike that found in some present claims, no general angle of projection in Townley '065 is recited; it is perpendicular. Thus, claims 31, 36, 40 and 41 distinguish over Townley, and, by virtue of their dependence, claims 33, 34 and 36 distinguish as well.

FURTHER REMARKS conclude the present paper (pages 7-11).

Submitted herewith is a Declaration with Exhibits.